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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031.723	04/29/2003	Leonard Maxwell	31574-00007	6153
24318	7590	06/16/2006	EXAMINER	
Mitchell, Silberberg & Knupp, LLP 11377 West Olympic Boulevard Los Angeles, CA 90064			KAPLAN, HAL IRA	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,723

Applicant(s)

MAXWELL ET AL.

Examiner

Hal I. Kaplan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-8, 13, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 is/are allowed.
- 6) ☒ Claim(s) 1-3, 13, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. The drawings were received on May 8, 2006. These drawings are accepted.

### ***Claim Rejections - 35 USC § 103***

2. The indicated allowability of claim 5, which was canceled in Applicant's amendments filed May 8, 2006, is withdrawn in view of the newly discovered reference(s) to Fujii et al. Rejections based on the newly cited reference(s) follow.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the international patent application publication of Peter (WO 97/01835) in view of the US patent of Fujii et al. (5,940,499).

As to claim 1, Peter, drawn to a proximity sensor, discloses, in Figures 1 and 7(a), a switch device comprising a face plate (30) and a single switch oscillator (60) having a capacitive component, the capacitive component having a first capacitor plate (25) arranged adjacent the face plate (30) (see page 6, line 22 through page 7, line 5), the face plate (30) preventing electrical contact between the user and the oscillator (60) whereby an object placed adjacent the face plate (30) acts as a second capacitor plate thereby altering a frequency of the oscillator (60) (see page 8, lines 10-12), control means (65,70,85) being provided to sense the change in frequency and to actuate the switch in response to such a change (see page 21, lines 5-15), wherein detection of the change in frequency of the switch oscillator (60) is achieved within the control means by software (see page 21, lines 16-17; page 22, lines 1-7; and Figure 8(a)). Peter does not disclose the software being arranged to filter out noise and/or frequency drift.

Fujii, drawn to a voice switch used in hands-free communications system, discloses a switch comprising a microprocessor (60), wherein software is arranged to filter out noise (see column 7, lines 59-61 and column 8, lines 29-34 and 44-47). It would have been obvious to one of ordinary skill in the art, at the time of the invention,

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to use software within the control means of Peter to filter out noise, in order to decrease the chance of a malfunction due to noise, without the need for additional hardware.

As to claim 2, in the switch device of Peter, the face plate (30) is made from electrically insulating material (see page 7, lines 4-5 and 16-18).

7. Claims 3, 13, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peter in view of Fujii, and further in view of the international patent application publication of Vora (WO 96/12291).

As to claim 3, Peter in view of Fujii disclose all of the claimed features, as set forth above, except for the face plate being arranged so that it can be retrofit to existing switch mountings. Vora, drawn to a touch responsive electric power controller with appliances, discloses, in Figure 12, a switch device with a face plate (19) arranged so that it can be retrofit to existing switch mountings (see page 43, lines 7-16). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to build the switch device of Peter in view of Fujii, with a face plate and housing as taught by Vora, in order to allow the switch device to be easily used with existing switch fixtures.

As to claim 13, Vora discloses a switch device, in which the switching device is used to switch a light circuit and in which hardware within the light circuit provides a gradual ramping up of current to the light (see page 11, lines 13-17).

As to claim 33, the switch of Vora is programmable by a user (see page 6, lines 6-10).

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8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peter in view of Fujii and Vora, and further in view of the US patent of Griffin, Jr. et al. (6,434,450).

Peter in view of Fujii and Vora disclose all of the claimed features, as set forth above, except for the programming of the switch being effected by the user selecting a function from a list of functions and logging the selection on the switch. Griffin, Jr. et al., drawn to an in-vehicle integrated information system, discloses a user-programmable switch wherein the programming of the switch is effected by the user selecting a function from a list of functions and logging the selection on the switch (see column 11, lines 40-46). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to effect the programming of the switch device of Peter in view of Fujii and Vora by the user selecting a function from a list of functions and logging the selection on the switch, as taught by Griffin, Jr., in order to make the switch more user-friendly.

***Allowable Subject Matter***

9. Claims 6-8 allowed.

10. The following is an examiner's statement of reasons for allowance:

Claim 6 is allowed because none of the prior art of record discloses the frequency from the oscillator being recalculated at fixed periods by the control means, in combination with the remaining claimed features.

Claims 7-8 are allowed because none of the prior art of record discloses the software within the micro-controller automatically detecting a frequency of a mains

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supply to which it is connected, via an AC zero detector circuit, in combination with the remaining claimed features.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

11. Applicant's arguments, see Remarks, filed May 8, 2006, with respect to the objections have been fully considered and are persuasive. The objections have been withdrawn.

12. Applicant's arguments with respect to claims 1-3, 13, 33, and 34 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal I. Kaplan whose telephone number is 571-272-8587. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 571-272-2800 x36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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